REMARKS

In accordance with the foregoing, claims 1-3, 10, 12-15, 22, 24-27, and 31 are amended for form.

No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

As set forth below, it is submitted that these claims clearly patentably distinguish over the art of record.

BACKGROUND

A Notice of Appeal was filed August 22, 2003. An interview with the Examiner was conducted on September 9, 2003. An agreement was reached that various of the claims be amended to recite that a copy guard signal is a signal indicating a copying restriction, and reducing functions deteriorate an image quality. A Preliminary Amendment further in response to the FINAL Office Action and amending claims as agreed at the interview was filed with a concurrently-filed, first RCE on September 22, 2003.

In the Office Action of October 22, 2003 (Paper No. 11), the Examiner conceded that Okamoto et al. (U.S.P. 5,627,655) does not disclose reducing to deteriorate image quality, but cited new art rejecting claims 1-3, 6, 10, 12-16, 18, 22, and 24-27 under 35 U.S.C. §103 over Okamoto in view of Adachi (U.S.P. 5,151,795). The Examiner also conceded that Okamoto and Adachi fail to describe preventing a video encoding circuit from outputting a video signal in a case where an output of screen information stored in storage device is ordered and information protected from copying, but rejected claims 4-5, 11, 17 and 23 under 35 U.S.C. §103 over Okamoto and Adachi in view of Hiroaki (P.N. 09083920). The Response filed January 22, 2004 traversed the rejections arguing that the Examiner had not established *prima facie* obviousness, features of the independent claims are not described by the cited art, and both Adachi and Kitazawa Hiroaki are nonanalogous art.

ITEM 6: RESPONSE TO ARGUMENTS

In Response to Arguments, the Examiner contends that Okamoto teaches a copying restriction since Okamoto *arugendo* teaches "copying only once." (Action at page 6).

Applicant points out to the Examiner that claims 1-3, 12, 13-15, and 24-27 as amended replace the term --copying restriction-- with the term "copying prohibition." Such a "copying prohibition" was presented in previous responses arguments and discussed with the Examiner during the interview. A "copying only once," which the Examiner contends is taught by Okamoto, does not teach a "copying prohibition."

ITEM 2(A): REJECTION OF CLAIMS 1, 10, 13, 16, 22, 25, 28, 33, 37, 41, 42, and 46 UNDER 35 U.S.C. §103(a) BY OKAMOTO IN VIEW OF ADACHI

The Examiner rejects claims 1, 10, 13, 16, 22, 25, 28, 33, 37, 41, 42, and 46 under 35 U.S.C. §103(a) over Okamoto in view of Adachi as set forth in Paper No. 11. (Action at page 2).

***Prima Facie* Obviousness Not Established**
Reducing Screen Information Not Taught By Cited Art Alone Or In Combination

Claims 1, 10, 13, 16, 22, 25, 28, 33, 37, 41, 42, and 46 recite reducing screen information. The Examiner concedes that that Okamoto fails to teach reducing information to deteriorate image quality. (Paper No. 11 page 3).

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

Adachi teaches only a compression method, not reducing screen information. In addition, the compression method of Adachi is not applicable to video signals, and is merely restricted to image signals. For example, Adachi teaches (col. 3, lines 20-22):

> images of a single object are recorded simultaneously or sequentially at some time intervals, have a high correlation to one another.

Applicant submits that it is well known in the art that to compress screen information only is a reduction in size or volume, does not teach "reduction" of screen information to deteriorate a signal, and that compression is to reduce in size or volume. For example, as described in Adobe's Video Codec Compression Methods:

> (s)ome codecs use lossless compression, which ensures that all of the information in the original clip is preserved after compression. This maintains the full quality of the original, which makes lossless compression useful for final-cut editing or moving clips between systems.

(Adobe at <http://www.adobe.com/support/techguides/premiere/methods/page3.html, 2003>).

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 1, 10, 13, 16, 22, 25, 28, 33, 37, 41, 42, and 46 allowed.

ITEM 2(B): REJECTION OF CLAIMS 1, 2, 13, and 25 UNDER 35 U.S.C. §103(a) BY OKAMOTO IN VIEW OF ADACHI

The Examiner rejects claims 1, 2, 13 and 25 under 35 U.S.C. §103(a) over Okamoto in view of Adachi as set forth in Paper No. 11. (Action at page 2).

Claims 1, 2, 13, and 25 recite "screen information includes a first part and a second part and the stored reduced screen information includes only the first part."

The Examiner contends these features are:

> . . . inherently present in the proposed combination of Okamoto et al and Adachi. Because, such a proposed combination would incorporate the capability of reducing and deteriorating the signals before recoding the same on the medium. Therefore, by reducing and deteriorating the video signal, it is noted that only part of the signal would forcedly be remained for recording purposes.

(Action at page 2).

Examiner's Contention of Inherency Unsupported

Applicant submits that the Examiner has not provided any support for such an inherency argument. As set forth in MPEP 2112:

> To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

That is, the Examiner does not provide the required support in rejecting the claim.

Conclusion

Since the Examiner's contention of inherency is unsupported, the rejection should be withdrawn and the claims 1, 2, 13, and 25 allowed. In addition, claims 1, 13, and 25 patentably distinguish over the cited art, as presented above in item 2(a).

ITEM 2(C): REJECTION OF CLAIMS 28, 33, 37, 41-42, AND 46 UNDER 35 U.S.C. §103(a) BY OKAMOTO IN VIEW OF ADACHI

The Examiner rejects claims 28, 33, 37, 41-42, and 46 under 35 U.S.C. §103(a) over Okamoto in view of Adachi as set forth in Paper No. 11. (Action at page 2). Claims 28, 33, 37, 41-42, and 46 recite "screen information is reduced by at least one of pixel reduction, line reduction, and frame reduction."

The Examiner contends these features:

> . . . would have been inherently present in the proposed combination of Okamoto et al, and Adachi. Since, the proposed combination would have already included the capability of reducing, deteriorating the quality of the inputted video data.

(Action at page 2).

Applicant submits that the Examiner has not provided the necessary support for such an inherency argument as et forth in MPEP §2112.

Conclusion

Since the Examiner's contention of inherency is unsupported, the rejection should be withdrawn and the claims 28, 33, 37, 41-42, and 46 allowed. In addition, claims 28, 33, 37, 41-42, and 46 patentably distinguish over the cited art, as presented above in item 2(a).

ITEM 2(D): REJECTION OF CLAIMS 2-3, 6, 12, 14-15, 18, 24 AND 26-27 UNDER 35 U.S.C. §103(a) BY OKAMOTO IN VIEW OF ADACHI

The Examiner rejects claims 2-3, 6, 12, 14-15, 18, 24, and 26-27 under 35 U.S.C. §103(a) over Okamoto in view of Adachi as set forth in Paper No. 11. (Action at page 2).

Independent claims 2 and 3 (and dependent claim 6) recite "recording screen information of picture information . . . a copy guard detecting circuit detecting a copy guard signal, indicating a copying prohibition." Claim 12 recites "a storage device, wherein screen information of picture information and picture information (is) stored at the storage device." Independent claims 14 and 26 recite a method and a computer-readable storage storing, respectively including "detecting a copy guard signal, indicating a copying prohibition . . . wherein picture information input from a first device is stored at a storage device in order to record and the stored picture information is outputted in order to reproduce."

Independent claim 15 (and dependent claim 18) recites a method " storing both digitized screen information and a fact that the copy guard signal has been detected." Independent claim 24 recites a method "adding a copy guard signal, indicating a copying prohibition . . . and outputting picture information stored at a storage device to reproduce." Claim 27 recites "storing to a storage device, both digitized screen information and fact that the copy guard signal has been detected."

Okamoto teaches that when a copy is permitted to be done only once, (col. 4 lines 20-21) "copy inhibition is determined and recording is not carried out." (Emphasis added). Applicant submits that *prima facie* obviousness is not established, since features of the claim are not taught.

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 2-3, 6, 12, 14-15, 18, 24, and 26-27 allowed. In addition, claim 2 patentably distinguishes over the cited art, as presented above in item 2(a).

ITEM 3: REJECTION OF CLAIMS 4-5, 11, 17 AND 23 UNDER 35 U.S.C. §103(a) OVER OKAMOTO AND ADACHI IN VIEW OF KITAZAWA HIROAKI (P.N. 09083920)

The Examiner rejects claims 4-5, 11, 17, and 23 under 35 U.S.C. §103(a) over Okamoto et al and Adachi in view of Kitazawa Hiroaki as previously set forth in Paper No. 11. Paper No. 11 concedes that the combination of Okamoto and Adachi fails to teach:

> . . . preventing the video encoding circuit form outputting the video signal in the case where an output of screen information stored in the storage device is ordered, and in the case where the information is protected from copying.

(Paper No. 11 at page 6).

However, the Examiner contends these features are taught by Hiroaki. (Paper No. 11).

Traverse

***Prima Facie* Obviousness Not Established**

Applicant submits that Kitazawa Hiroaki does not teach an image processing apparatus recording screen information, as recited in Applicant's claims 4, 5, and 11 or a method for controlling image information, as recited in Applicant's claims 17 and 23. Kitazawa Hiroaki discloses only a picture processor apparatus describing when a copy guard signal is detected printing out "characters to the recording part."

Conclusion

Since *prima facie* obviousness is not established, the rejection of claims 4-5, 11, 17 and 23 should be withdrawn and the claims allowed.

ITEM 4: REJECTION OF CLAIMS 29-31, 34, 36, 38-40, 43, 45 AND 47-49 4 UNDER 35 U.S.C. §103(a) OVER OKAMOTO AND ADACHI IN VIEW OF FIG. 2 (APA)

The Examiner rejects claims 29-31, 34, 36, 38-40, 43, 45 and 47-49 under 35 U.S.C. §103(a) over Okamoto and Adachi in view of APA.

The Examiner contends that Okamoto and Adachi teach "storing reduced screen information to a storage device in a case where copy guard detecting circuit detects the copy guard signal indicating copying restriction (prohibition) as specified in present claims 29-31, 34, 36, 38-40, 43, 45, and 47-49." (Action at page 3).

Applicant submits that *prima facie* obviousness is not established since features of the claims are not taught by the cited art. Neither Okamoto or Adachi teach reducing screen information, let alone storing reduced screen information.

Conclusion

Since features of the claims are not taught by the cited art, and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 29-31, 34, 36, 38-40, 43, 45 and 47-49 allowed.

ITEM 5: REJECTION OF CLAIMS 32, 35, AND 44 UNDER 35 U.S.C. §103(a) OVER OKAMOTO, ADACHI, AND HIROAKI IN VIEW OF APA

The Examiner rejects claims 32, 35, and 44 under 35 U.S.C. §103(a) over Okamoto Adachi, and Hiroaki in view of APA. (Action at pages 4-5).

Dependent claim 32 recites "inputted picture information displayable on a screen of a display device is not reduced." Dependent claims 35 and 44 recite "wherein inputted picture information is displayable on a screen of a display device without being reduced both when the screen information is both protected, and not protected, from copying."

The Action concedes that these features are not taught by the combination of Okamoto, Adachi and Hioraki (Action at page 5). The Examiner contends however, that it is obvious to modify the proposed combination with the APA

No Motivation To Modify Cited Art In A Manner Suggested By The Examiner

As provided in MPEP §2143 entitled Basic Requirements of a *Prima Facie* Case of Obviousness:

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Okamoto teaches merely a recording apparatus and a reproducing apparatus. There is not teaching at all in Okamoto to incorporate a display screen with features as recited in present application's claims.

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claims 32, 35, and 44 allowed.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome. Applicant respectfully submits that all claims patentably distinguish over the prior art, taken alone or in any proper combination.

There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If there are any additional fees associated with filing of this Preliminary Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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